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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,045	03/16/2001	Robert E. Scott	D6386/D	7993

7590

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EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 09/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/811,045

Applicant(s)

SCOTT, ROBERT E.

Examiner

MISOOK YU, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2002 and 02 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Sequence alignment*.

### **DETAILED ACTION**

Claims 10-12 are pending and examined on merits.

#### ***Priority***

Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application repeats a substantial portion of prior Application No. 08/801,308, filed February 18, 1997 now US Pat. 6,368,790, and adds and claims additional disclosure not presented in the prior application. Applicant's attention is directed to page 25 lines 9-10 of the instant specification, which is added in the instant application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

#### ***Specification***

The objection of specification is withdrawn in view of the amendment.

***Claim Rejections - 35 USC § 112***

Claims 10-12 are rejected for different reasons (see below) under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendment.

Claim 12 depends on claim 11, which depends on base claim 10. Claim 10 has the limitation "antibody is prepared" against a protein encoded by SEQ ID NO:2. But it is not clear what the metes and bounds. The dependent claim 12 is drawn to C120, raised with an epitope which is not encoded by instant SEQ ID NO:2. The specification sheet on the catalog number sc-9962, PACT (M56) downloaded from Santa Cruz Biotechnology web site says that PACT (M56) is raised against amino acids 753-909 of a protein not encoded by instant SEQ ID NO:2. Note the attached sequence alignment against what is being said about the antibody of instant claim 12.

The rejection of claim 12 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn since applicant states in the response filed on 11-05-2002 that the antibody designated as C130 recited in the instant claim is identical to PACT (M56) sold by Santa Cruz Biotechnology, Inc.

***Claim Rejections - 35 USC § 102***

Claim 10 and 11 are rejected for reason of record under 35 U.S.C. 102(b) as being anticipated by either Minoo et al (Nov. 1989, The Journal of Cell Biology, Vol. 109, pages 1937-1946) or Witte et al (1993, Mol. Cell. Differ. Vol 2, pages 185-195)

and also rejected for reason of record under 35 U.S.C. 102(e) as being anticipated by US PAT 5,634,761.

Applicant argues that the amended claim 10 is drawn to antibody raised against a protein encoded by instant SEQ ID NO:2, claim 11 is directed to antibody that binds specifically to instant SEQ ID NO:1, and the antibodies taught by the art bind to instant SEQ ID NO:1 because instant SEQ ID NO:1 and the proteins the antibodies of art binds to share common epitopes. These arguments are considered fully but found unpersuasive. As for instant claim 10, the antibodies of prior art binds to the protein encoded by instant SEQ ID NO:2 as evidenced by applicant's own admission in the amendment (Paper No. 10) and also throughout the entire specification. How the antibody is prepared is not given a patentable weight because the instant claim is drawn to a product per se. As for claim 11, applicant argues with limitation not present in the claim. Instant claim 11 says that an antibody is within the scope of the claim as long as it binds to the carboxy-terminal half of SEQ ID NO:1, the claim does not say an antibody has to specifically bind to the carboxy-terminal half of SEQ ID NO:1.

## **NEW GROUNDS OF REJECTION**

### ***Claim Rejections - 35 USC § 102***

An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: Instant specification at page 25 lines 9-10 appear to say that C130 has ATCC Number. Instant specification does not have any information that C130 is same as the catalog

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number sc-9962, PACT (M56) from Santa Cruz Biotechnology. Applicant <sup>newly ~ 9-8-03</sup> argues in the amendment filed 11-15-2002 that the antibody of instant claim 12, i.e., C130 is commercially available from Santa Cruz Biotechnology with different name, i.e. PACT (M56). Based on the specification sheet of the catalog number sc-9962 from Santa Cruz Biotechnology downloaded from the web site, the product is raised against amino acids 753-909 of a protein not encoded by instant SEQ ID NO:2, but encoded by a protein whose sequence was disclosed by someone else other than the inventor of the instant specification. Note the specification sheet of the catalog number as well as the attached sequence alignment, especially the information about where the epitope sequence of PACT (M56) is originally disclosed. The Office requests that applicant provide the information about (1) who invented "C130" claimed in the instant claim 12, and (2) when "C130" become commercially available.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Misook Yu whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu, Ph.D.

September 5, 2003

  
ANTHONY C. CAPUTA  
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